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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/809,329
Filing Date: March 26, 2004
Appellant(s): LEVITAN ET AL.

S. Warren Hall
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 12, 2010 appealing from the Office action mailed November 12, 2009.

Art Unit: 3717

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-8, 11, 12, 14-16, & 18-24 are pending in the application.

Claims 9, 10, 13, & 17 are cancelled.

Claims 1-8, 11, 12, 14-16, & 18-24 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Evidence relied upon in the rejection of the claims under appeal:

2002/0103109	Emmerson	8-2002
2001/0034643	Acres	10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-7, 11, & 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerson (U.S. Patent Application Publication No. 2002/0103019; of record).

Claim 1: Emmerson discloses the invention substantially as claimed including a personal portable device (i.e. mobile or cellular telephone – paragraph 0002) to be carried by a user and having a primary practical function (i.e. to make telephone calls) and a secondary personal entertainment function (i.e. to play games), the primary practical function including the capability to communicate

over a wireless communication network with a separate computer (figure 2 & paragraph 0022), the secondary personal entertainment function includes a series of downloadable games downloaded to the personal portable device using the communication capability of the primary practical function to form a wireless connection with a game server computer and have the game server computer download at least one additional game, the at least one additional game including as part thereof a tracking arrangement including a database (i.e. memory) for tracking usage information of a plurality of users on the device with respect to the play of the at least one game and to communicate the use information to the game server computer over the wireless communication network when the personal portable device is in communication with the game server computer (see at least paragraphs 0022-0026, 0032-0033, & 0040-0041), the at least one game being operable to receive from the game server computer when the personal portable device is in communication with the game server collective results for said at least one game of other personal portable devices including high scores and collective high score ranking information (paragraphs 0040-0041, where Emmerson discloses that game server receives scoring information from each of a plurality of players, updates a league table with the standings of each player and informs the player where he stands in the league table, thus collective use information is obtained and a high scores and ranking is provided).

Emmerson appears to lack an explicit disclosure that the game is selectively playable in a local mode and a registered mode where each mode includes game summary information maintained on the personal portable device including a series of high scores for a plurality of collective users, the high scores in the local mode accepting any identified user and the high scores in the registered mode requiring each user to be registered with the game server, where the high scores are uploaded to the game server from the personal portable device.

Nonetheless, the Examiner submits that (1) a local mode for a game device is notoriously well known in the art; and (2) Emmerson reasonably discloses the registered mode in which registered players upload their scores to a game server; thus, it would have been an obvious matter to modify Emmerson to operate in either mode based on game play, high score achieved, or selection by the player.

As to (1) above, it is notoriously well known in the art for devices having games playable thereon, such as mobile phones, arcade games, gaming consoles, personal computers, and the like, to offer a local mode where any username desired may be entered by a player when a score eligible for the high scores list is achieved in the game. Such a 'high scores' list or leader board is a well known concept in the gaming arts and has been employed in a plethora of games on various platforms and devices and the like for decades. Those skilled in the art would recognize such a mode is common practice in the gaming art. For instance, the Examiner submits, as evidentiary, at least U.S. Patent Application Publication No. 2003/0093168 to Nagaoka (see at least figure 3 and the related description thereof, further figures 7A-7D depict mobile game application screens, where at least local ranking information is a game menu option for display of a local high scores list) and U.S. Patent No. 6,709,335 to Bates et al. (column 19, lines 40-62), each teaching at least a local mode in which a local high scores is maintained for a mobile gaming application. Accordingly, a "local mode" would have been *prima facie* obvious and a skilled artisan would have had good reason to pursue the addition of a local mode to Emmerson for at least the reason to allow players to practice or simply play games for enjoyment locally without competing against other players or submitting their scores to a server, wherein the local high scores lists aids in assisting a player to practice beating a previous high score or further allows multiple local players to attempt to obtain a high score.

Next, as to (2) above, Emmerson discloses a modern age of competition based on high scores in a game, whereby instead of being limited to compete against friends or family local to the game device, a player enjoys the excitement of competing globally with anyone that has the same game. Emmerson discloses a user initially registers with the game server, or if the player has previously registered, allowing the player to participate in gaming activities such as downloading games, submitting scores, receiving collective scores, or the like (paragraphs 0025-0026). Thus, Emmerson essentially appears to disclose a registered mode requiring each user being registered with the game server and their score being uploaded to the game server. Emmerson appears to suggest that scores be uploaded to a game server for the purpose of competition. In a similar version of Emmerson, it would have been an obvious matter to merely upload game scores and maintain a global 'list' of scores in a single-player type game, as 'the game' referenced is an obvious design consideration. For instance, a single player game such as the old and well known Tetris operable in a registered mode merely allows a player to submit their score to an online leader board or list of high scores so that others can see their registered name associated with a score or attempt to beat other registered players' scores. Such a version does not appear to discourage any players as anyone may obtain a high score and add their registered name to the high scores list.

Consequently, given the teachings of Emmerson combined with a well known 'local mode' as claimed, it would have been *prima facie* obvious to one of ordinary skill in the art to modify Emmerson to allow play of games in a local mode for the purpose of allowing the player to practice or simply play for enjoyment, and further allow a player to play the game in the registered mode competing against other players globally, after they've had the opportunity to practice and enhance their skills. Furthermore, in a broad sense, Appellant's claimed local mode and registered mode may be correlated to well known "single player" and "multi-player" modes in a vast plethora

of known games. For instance, certain known games having a single player mode allow a player to play a game in a single player mode allowing the player to enhance their skills. These single player modes are known to include a high scores list for single player play or 'local play'. Similarly, the multi-player play as is known, allows for players to play over a network against non-local players, which normally requires a registered name, where the registered mode also includes a global high scores list of all playing in the multi-player mode. It should also be noted that 'the game' referenced above need not necessarily be any particular game referenced within Emmerson, that is, any compatible game or game type may employed on the personal portable device of Emmerson, thus, Tetris as discussed above may be played in a local or single player mode (i.e. game play with local high scores) or in a registered or multiplayer mode (i.e. same game in which resultant scores are submitted to a global high scores list). Therefore, a specific local mode and specific registered mode each having their own collective series of high scores does not appear to patentably distinguish over the known prior art and common practice in the art.

Claim 3: Emmerson discloses mobile gaming, where the mobile gaming is carried out on a wireless telephone device, such as a mobile or cellular phone, said phone is in wireless communication to access and communicate with a game server (figure 2 & paragraph 0002).

Claim 4: Emmerson discloses a web browser application as being present on the mobile phone (paragraph 0024). Emmerson also discloses a subscription/registration process, whereby a player must have initially subscribed or registered to the game server to participate in multiplayer games through the game server. Thus, upon connection to the game server, the server performs an authentication process to determine if the player has previously subscribed and has access to the game server. If yes, access is granted and the game selection process continues. However, if no subscription is determined, the player is denied access and alternatively provided with instructions

on how to register/subscribe and pay the necessary fees to access the game server. Further, for purposes of filling out a registration or subscription form, the browser on the mobile phone must be utilized, thus, Emmerson discloses allowing a user to initially register with the game server, or if the player has previously registered, allowing the player to participate in gaming activities such as downloading games, submitting scores, receiving collective scores, or the like (paragraphs 0025-0026).

Claim 5: Emmerson discloses that at block 260 (figure 4), the server downloads an updated league table with collective use information to the player's mobile phone, where such information is selectively displayable when the player wishes to view his standings in the league table (paragraph 0041).

Claim 6: Clearly there must be a display function to use the mobile phone's LCD (paragraph 0002) to display game information such as collective use information, amongst other information. Emmerson discloses a game menu (paragraph 0008), and discloses that the display includes at least collective game use information received from the game server computer (paragraph 0041 and figure 4[step 260], where the user is informed of his standing in the scores list, which must be displayed on the device).

Claim 7: Emmerson discloses a series of games being downloaded to the mobile phone (paragraph 0041, where Emmerson discloses upon a player submitting a new game outcome or result, the game server could send out the next fixture or level in the competition, where the competition has multiple games, fixtures, levels, or the like, thereby being a series of downloaded games). It would have been obvious to a skilled artisan to explicitly use common game menus (i.e. similar themes or the like) for allowing a user to access game use information. Additionally, as each

next fixture or level may be sent out as the series of games, it would appear implicit that each fixture or level of a common game would include common game menus.

Claim 11: Emmerson discloses the personal portable device is a mobile or cellular telephone, as discussed above, which may be interpreted as a personal data assistant as a mobile phone assists in personal data (i.e. address book). Emmerson discloses the personal data assistant is connected to operator server (figure 2[server 42]), which relays communication to the game server (figure 2[server 31]) connected to the operator server.

Claim 18: Emmerson discloses the at least one game is operable in a tournament for fame mode where the game server computer receives and processes game result from a group of personal portable devices (paragraph 0008).

Claim 19: See the rejection of claim 3.

Claims 20 & 21: Emmerson as modified and discussed above with respect to claim 1 teaches that a player would have access to both high scores list in the local mode or in the registered mode, such that it would be an obvious matter that the 'game' in local mode allows access to high scores for registered mode (i.e. even if the player is not registered, downloading of a known global high scores list is an obvious design consideration).

Claim 22: Emmerson as modified makes obvious the local mode as discussed above, where the local mode includes a high scores game screen. Emmerson does not explicitly disclose the game screen includes an icon for accessing high scores for the registered mode, however, such graphical user interface limitations here are merely functional limitations presented in an apparatus claim, thus, the Examiner submits that the display screen of the game device as taught by Emmerson as modified is capable of displaying a game screen in a local mode including an icon for accessing high scores for the registered mode.

Claim 23: As discussed above, Emmerson discloses game menus, such as to navigate various game options. Emmerson explicitly lacks a login screen, however, given Emmerson as modified including both a local mode and a registered mode, it would have been notoriously obvious to a skilled artisan to include a login screen to allow a player to access the registered mode or play in a local mode as a guest or any desirable alias. Given the discussion of a local mode and registered mode, it appears *prima facie* to allow the user to select which mode and login if necessary.

Claim 24: Emmerson discloses a game menu option (i.e. a request to see high scores) that when actuated causes the device to obtain from the game server computer high scores for the at least one game based on registered users and store the high scores in the database and display the high scores on the device when initiated by the user (paragraph 0024, 033, and 0040-0041, where Emmerson discloses game menus and receiving high scores for registered users, which must be saved in at least the devices memory or "database").

Claims 2, 8, 12, & 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerson, as applied to claims 1, 3-7, 11, & 18-24, where applicable, in view of Acres (U.S. Patent Application Publication No. 2001/0034643).

Claims 2, 8, 12, 14, & 16: Emmerson discloses the invention substantially as claimed except for explicitly disclosing a sweepstakes mode, the sweepstakes mode being based on various gaming activities such as an entry for each time at least one game is played and communicated to a game server during a predetermined time period, an entry for registration and the number of times the eligible games are played and communicated to the game server, or an entry each time a game in the sweepstakes mode is simply played. Regardless of such a deficiency in Emmerson, those of ordinary skill in the art would have found such a sweepstakes mode to be a notoriously well known

option in the gaming arts for implementation in a variety of gaming applications. Specifically, the Examiner submits that Acres explicitly teaches a sweepstakes mode of gaming in which an advertisement system may provide an incentive for a user to play a game and view advertisements by offering rewards such as entries to sweepstakes based on a variety of gaming activities, such as a user who completes a game within a certain period of time, a user who has one of the 10 highest scores, or a user who has one of the longest winning streaks may receive this additional reward (paragraph 0018). While Acres is directed to casino gaming using gaming terminals (i.e. slot machines or the like), the teachings of Acres appear applicable in a variety of different gaming applications (i.e. mobile gaming, computer gaming, console gaming, etc.). Given Acres teachings, one skilled in the art would have found it obvious to implement a sweepstakes mode in the mobile games played within the Emmerson invention to benefit both the players (i.e. providing additional ways to win – a sweepstakes drawing) and the gaming hosts (i.e. additional revenue from advertising sponsors). The concept of advertising and providing additional awards, such as sweepstakes entries or raffle tickets, has been notoriously well known in the art for some time. Acres, as seen in figure 1, has four portions of the game screen dedicated to advertisements, and as is known in the marketing industry, advertisements are not cheap, thus clearly the gaming hosts are generating a plentiful revenue stream from these advertisements. Consequently, the gaming hosts are able to offer a wide variety of additional bonuses or rewards to players for their loyalty and game play. Therefore, for at least the reasons provided, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Emmerson to implement a sweepstakes “mode” of the mobile games applications. Further, it would have been obvious to base the individual entries off a plethora of possible measurable gaming activities including those discussed above, for at least the reason that if Acres provides sweepstakes entries for such activities

Art Unit: 3717

as obtaining a high score, it appears any gaming activities that could be monitored or measured in some way could be use by a game designer to implement the known sweepstakes mode based on said gaming activities. Regarding claims 12 & 16, as previously explained, Emmerson discloses downloading a plurality of games, where in view of Acres, at least some of the games would have game menu options to allow play of said games in a sweepstakes mode.

Claim 15: Emmerson discloses mobile gaming, where the mobile gaming is carried out on a wireless telephone device, such as a mobile or cellular phone, said phone is in wireless communication to access and communicate with a game server (figure 2 & paragraph 0002).

(10) Response to Argument

35 U.S.C 103(a) Rejections over Emmerson

Claims 1 & 11

Appellant, at page 8 of the brief, argues that:

“Emmerson does not include games with a database as required in claim 1 and certainly does not include games where the database is updated and includes high scores and collective high score ranking information for both the local mode and the registered mode that is maintained on a personal portable device. Emmerson, in paragraphs 0040-0041 merely states that the game device receives a message from the server confirming receipt of the game information and information the user of where he stands in the league table. It is respectfully submitted that this is not the downloading of high scores and collective high score ranking information, but merely a single result of where a user ranks overall”.

The Examiner respectfully disagrees. First, the Examiner submits an summarized applicability of Emmerson to at least the invention of claim 1. The invention of claim 1 includes a personal portable device (hereinafter "mobile device") having a primary practical function (i.e. making telephone calls) and a secondary entertainment function (i.e. play games), with the capability to communicate over a wireless communication network. The mobile device enables games to be downloaded from a game server, wherein each of the games “includes a tracking arrangement including a database for tracking use information of a plurality of users on said device” with respect to the play of a game, and may communicate said use information to the game server. Each of the games is operable in a local mode or a registered mode. The local mode allows any player to play the game and submit any identified user name to submit a score to a high scores list stored locally in the database. The local mode is akin to the high scores list operable on any standard arcade

game (i.e. player may use their initials to place their score on a high score list of the arcade game). On the other hand, the registered mode allows submitting of high scores to a game server to allow registered players to compete, globally perhaps, with other registered players, wherein a game server receives high score information from said registered players and maintains a collective high scores list among all the registered players. The collective high scores information may be downloaded to the mobile device for viewing. The registered mode is essentially an "online" or global high scores list requiring registration to submit a score. The database is essentially interpreted as a memory of the mobile device storing use information, as is commensurate with Appellant's specification, wherein the use information as discussed above is merely scoring and/or ranking information of players utilizing the mobile device in either a local or registered mode, including storing a high scores list.

The rejection of claim 1 sets forth Emmerson, who clearly teaches a mobile device, such as a cell phone, wherein games may be played via a game server. Emmerson discloses registered mode operation of games, wherein players register with a game server, perform game play, and subsequently submit their scores to a global league table or high scores list. The Examiner submits numerous reasons why one skilled in the art would have found it an obvious matter to implement a well known local mode for the same games as provided a registered mode within Emmerson, such as to allow players to practice certain games prior to having the confidence to compete against players in a registered mode, whereby their scores would be shown for all registered players to view. The board would benefit from the detailed discussion of a local mode implemented within Emmerson as discussed in the rejection of claim 1 set forth above. In view of the obviousness set forth, Emmerson as

modified makes obvious a game operating on a mobile device in both a local mode and a registered mode, wherein in the local mode a player may practice or merely play a game for leisure and use any identified name to place a score on a local high scores list (i.e. similarly to any initials or the like in well known arcade, console, and mobile games), and in the registered mode submitting scores their registered name to a global or online high scores list. Moreover, Emmerson discloses a database or memory unit allow information to be stored, thereby Emmerson as modified would have utilized the mobile device's memory means for storing a local high scores list during a local, and Emmerson sets forth downloading of high scores from use information during the registered mode as discussed above.

Returning to Appellant's argument, the Examiner respectfully disagrees that Emmerson, as modified in the rejection set forth above, fails to disclose games with databases and updating high scores for a local and registered mode that are maintained in the mobile device. Appellant further alleges that when Emmerson discusses receiving a message from the server information the user of where he stands in a league table, that such disclosure is merely a single result of where the user ranks overall and not a collective high scores list. The Examiner disagrees. Emmerson, at paragraph 0040, discloses "As indicated at block 240, the server receives the outcome as either a result perhaps including a score or a void game. The server registers the result and on that basis updates the league table at block 250. Any user may view the new tables". Accordingly, Emmerson discloses that during at least a registered mode, scores are sent to a game server, and the game server makes available viewing of any updated league tables or high score lists. If the league table information is updated at the game server and any user (registered) may view the new

tables, upon a user selecting to view the updated league table, the server must transmit such information to the game device. Upon transmitting this data to the game device, the game device must store this data, such as in a memory or database of the mobile device.

Appellant argues that Emmerson lacks games including databases. It appears that Appellant's specification indicates the database are not part of the games themselves, but rather the database is a database of the mobile device, or essentially a memory unit of the mobile device. Therefore, as Emmerson must receive data to show the data to the player on the mobile device's screen, this data must be stored in a database or memory of the mobile device. Similarly, Emmerson, as modified including a local mode, would have utilized the memory of the mobile device to store high scores lists for local players during the local mode. Therefore, the Examiner respectfully submits that Emmerson, as modified, discloses games with a database (i.e. the memory of the mobile device), wherein the database is updated including high scores or collective high score ranking information for both the local mode and the registered mode that are maintained on the mobile device. As an additional note, the Examiner included at least two evidentiary references in the rejection as set forth above to convey to the Appellant that a local model wherein local users merely store a high score list on a local device, using any identified name (i.e. a user's initials, or the like) is a notoriously well known concept in the gaming industry. Arcade games have been storing local high score lists in such a manner for decades, wherein those skilled in the art would have possessed the common knowledge and routine skill to implement such a local mode within Emmerson.

Appellant, at page 9, alleges "At best Emmerson merely teaches sending a communication to the device providing a ranking and there is no disclosure of modifying

games to include a database for storing this information and allowing subsequent access thereto". The first portion of this statement is addressed above. The Examiner points out to the board that "and allowing subsequent access thereto" is not commensurate with the scope of either claim 1 or 11.

Appellant, at pages 9-10, further argues that Emmerson appears to track information on the game server, but does not disclose games operable on a mobile device having a database. This appear to the further Appellant's previous argument presented above. Additionally, Appellant discusses that with the claimed structure, each of the plurality of games includes a tracking capability and there is no requirement to include additional software or a separate database for each game. The Examiner submits that upon downloading of high scores as discussed above, for any of the plurality of the games playable on the Emmerson device, the use information is stored in the database. The claimed "tracking arrangement" appears to be only a database, thus a memory unit of Emmerson is essentially a tracking arrangement including a database for tracking user information of a plurality of users as discussed in detail above.

Appellant, at pages 10-12 of the brief alleges that the Examiner's submitted evidentiary references are deficient in establishing that it is well known to provide games for personal portable devices with a local mode and the tracking as specified in the present claims. Initially, the Examiner submits that it appears the Appellant is attack each reference as failing to teach the entirety of the claimed invention including a mobile device in a both a local mode and registered mode, etc. The Examiner respectfully submits that these two evidentiary references are relied upon as teaching references to convey to the Appellant that a local mode wherein local high scores are maintained is a well known aspect in the

gaming industry. All types of games (arcade games, console games, mobile games, etc.) teach local high scores lists, wherein the games including a 'tracking arrangement' or database storing collective high score information of a plurality of users, identifiable by any name or alias. Accordingly, given the reasons why the local mode is notoriously well known in the art and one of ordinary skill in the art would have found it *prima facie* obvious to implement the local mode within Emmerson to provide games operable in both a local mode, for such purposes as practicing, and a registered mode, for such purposes as global competition. Thus, Emmerson, as modified, would have provided summary information maintained on the personal portable device including a series of high scores for a plurality of collective users including in the local mode the high scores accepted using any identified name of the user. Additionally, Emmerson discloses the ability for a user to view updated league tables from a game server thereby requiring downloading and saving of the updated league table on the mobile device, the table including collective high scores and/or ranking information of a plurality of registered users.

Appellant, at pages 12-13, discusses a number alleged benefits claimed invention over Emmerson, as modified. While these allegations are noted, the Examiner maintains that Emmerson, as modified with games operable in a local mode as is well known and the registered mode taught, applies to the claimed invention, whereby Emmerson, as modified, teaches a game for a mobile device capable of tracking use information in a controlled environment (i.e. within the memory of mobile device) determined by the user in the local mode and the ability at some point in the future to consider playing the same game in a registered mode. That is, it is known that "practice makes perfect". Implementing the same game having a local and registered mode, as presented above, allows for games to practice

Art Unit: 3717

and hone their gaming skills via a local mode prior to participating via a registered mode within a global or competitive scenario.

Claim 3

Appellant, at page 14, argues that "the prior art references teach a different solution of providing the information on the game server and using the communication capability of the phone to access the information". The arguments presented for claim 3 appear to be non-commensurate with scope of the claim. Claim 3 merely requires the personal portable device is a cell phone used to access and communicate with the game server over a wireless communication link. Emmerson clearly teaches the personal portable device is a cell phone (figures 1-2 and paragraph 0005, wherein mobile phones are capable of downloading games from a game server and submitting outcomes to a game server; see also paragraph 0022, wherein the communication link is wireless).

Claim 4

Appellant, at page 14, argues that "Emmerson is based on accessing a game server and teaches away from the downloading of registered user results to the device and maintained thereof on the device in a database thereof". The Examiner respectfully disagrees. Emmerson discloses the mobile device communicates with the game server to upload and download data, including games, levels, and use information, such as high scores or league tables (paragraph 0005). While Emmerson discloses "posting" of high scores or league tables, clearly for a user to access a game server and view such high scores information, the user must download data regarding this information for viewing of the data on the display screen of the mobile device. This information is downloaded to the memory or database of the mobile device and thus is maintained therein. It should be noted the received data regarding the high scores must be maintained at least for some time to allow viewing of the information by the player on the mobile device.

Claim 5

Appellant, at page 15, with respect to claim 5 appears to make a number of statements, however, no argument appears to have been presented. Accordingly, no response can be provided.

Claim 6

Appellant, at page 15, argues that “Within the at least one game, a game menu is accessible to display the game use information. This is possible as the at least one game cooperates with the database to make this information available by selecting an appropriate game menu option. None of the references operate in this manner as the information is only available after connection to a game server that maintains and presents registered user game information and not as part of game play”. These arguments are acknowledged, however, none of these arguments appear to be commensurate with the scope of claim 6. Claim 6 merely requires the at least one game to include a game menu with a display function for displaying game use information received from the game server. Emmerson clearly discloses game menus (paragraphs 0002, 0008, 0024, etc.), wherein functions of gaming operate via the game menus, such as to connect to the server and play a game. Additionally, as discussed throughout this Examiner’s Answer, Emmerson discloses transmitting game use information from the server to the mobile device. Thus, if Emmerson discloses game functions are operated via game menus, the game menus would naturally be utilized to selectively obtain game use information of a global competition game, such as downloading updated league tables from the server as previously discussed. Consequently, in the scope of claim 6, Emmerson, as modified, teaches a game menu with

a display function (i.e. a menu option to access the league table) for displaying game use information received from the game server.

Claim 7

Appellant, at pages 15-16, argue in connection with parent claim 6, that the references operate on accessing the game server frequently and only appeal to a limited group of customers. Again, Appellant's argument does not appear to be commensurate with the scope of claim 7. Claim 7 requires a series of games downloaded to the mobile device to use common game menus for allowing a user to access game information. Emmerson discloses a specific "Games" menu, wherein any game stores on the mobile device is accessible via a common games menu, thus, any information associated with any of the games stored thereon is also accessible via common game menu (paragraph 0002, wherein a user navigates through a phone's various menu options, selects the 'Games' options and then selects a particular game he/she wishes to play, thus, each stored game includes at least one common game menu).

Claims 18 & 19

Appellant has not presented any arguments with respect to claims 18 & 19. Thus, no response can be provided.

Claims 20 & 21

Appellant, at page 16, argues that the cited art only makes information available by contacting a game server and viewing information maintained by the game server, wherein the system of the claimed invention is different from Emmerson, as modified. As discussed above the Examiner submits that any data to be viewed and accessed from the game server must be downloaded or received by the mobile device and maintained for at least some

time period. Furthermore, as discussed above, Emmerson discloses game menus, thus in Emmerson, as modified, a player operating a game in either a local or registered mode may operate an option to access both high scores for local mode and high scores for registered mode via the game menus, wherein high scores data is at least stored in the database of memory of the mobile device, such as upon receiving data or retrieving the local mode data. Regarding claim 21, Emmerson, as modified appears to suggest a game in local mode having access to high scores in a registered mode, such upon executing a game in which a player has yet to register, whereby the player may obtain collective high scores data from registered users from a local mode to determine the competition before deciding to register to compete in the registered mode. Such a design consideration is well within the ordinary level of skill. In competitive events or games, it is beneficial for participants to gauge the level of skill prior to joining or entering, thus, those skilled in the art would have further been obvious to allow within Emmerson, as modified, a player to obtain a league table of the registered mode game play to gauge the level of skill.

Claim 22

Appellant, at page 16, with respect to claim 22 appears to make a number of statements, however, no argument appears to have been presented. Accordingly, no response can be provided.

Claims 23 & 24

Appellant, at pages 16-17, with respect to claims 23 & 24 appears to make a number of statements, however, no arguments appear to have been presented for either claim with respect to the rejection applied to claims 23 or 24. Accordingly, no response can be provided.

35 U.S.C. 103(a) Rejections over Emmerson in view of Acres

Claims 2 & 14

Appellant, at page 19, argues that Acres discloses “a sweepstakes mode is to provide a reward for the player to play the game and view the advertising. However, there is no consideration of a personal portable device that has local mode and registered mode in combination with a sweepstakes mode where the player is rewarded for participation.” First, it should be noted that Acres relied upon to teach a limitation missing from Emmerson, as modified, including a sweepstakes mode. Emmerson, as modified discloses the local mode and registered mode as discussed above. Acres provides motivation to one skilled in the art to further provide a sweepstakes mode, wherein a player may be rewarded, such as by sweepstake entries, merely for participating in the game. Acres, at paragraph 0018, discloses that incentives may be provided to users of a game, such as rewards including sweepstake entries, merely in response to user's playing the game and viewing advertising associated therewith. Appellant later argues that the sweepstakes incentive associated with the Acres reference is associated with viewing of advertising and there is no recognition that a game without such advertising would be advantageous to operate in a sweepstakes mode. However, Appellant's own specification of the claimed invention appears to indicate their sweepstakes mode operates in conjunction with sponsor advertising (Appellant's specification, paragraphs 0014 and 0037; references to published application number 2004/0242325). Clearly, advertising allows for sweepstakes to be operated due to the revenue stream received from the advertising. Consequently, Acres appears to explicitly teach a sweepstakes mode allowing for sweepstake entries as an incentive, at least one time per game play (Acres, paragraph 0018). Given the teachings of

Acres, those skilled in the art would have been motivated to implement a sweepstakes mode in the mobile games played on the Emmerson mobile device, to benefit both players (i.e. to provide additional ways to win via sweepstakes drawings) and the gaming operators (i.e. advertising revenue). Lastly, Appellant argues that the combination of Emmerson, as modified and Acres is only hindsight based with knowledge of the present disclosure. In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The combination only takes into consideration knowledge which was well known at the time of Appellant's invention. For instance, sweepstakes have been extremely well known, and Acres bridges the gap by explicitly teaching that providing sweepstakes entries for merely playing games is beneficial as discussed above. Thus, it would have required only routine skill to implement a substantially equivalent sweepstakes mode within the mobile games of Emmerson, as modified, to provide sweepstake entries merely for playing games on the mobile phone, wherein as discussed in Appellant's own specification, said mobile games may include advertising. Clearly, the entire reason to include advertising in a game is for users to see said advertising, thereby allowing the game operators to receive revenue for these advertisements. Moreover, to encourage more and more game play, thus more and more

exposure to said advertisements, game designers would have found it beneficial to provide incentives, such as sweepstakes entries as taught by Acres.

Claim 8

Appellant, at page 20, argues the prior art encourages game play on a server. This argument appears to be the only clear argument presented for claim 8 and this argument does not appear to be commensurate with the scope of the claims. Claim 8 requires the plurality of games on the mobile device being eligible to operate in a sweepstakes mode based on registration and a number of times the eligible games are played and communicated to the game server. As discussed in detail above with respect to claims 2 & 14, Emmerson, as modified in view of Acres makes obvious games operated in a sweepstakes mode, such as a game of Emmerson operable in a registered mode receiving sweepstake entries each time the game is played and a result is communicated to the game server.

Claims 12 & 16

Appellant, at pages 20-21, makes a number of statements and arguments directed to authentication. It is unclear as to the applicability of these statements and arguments with respect to claims 12 & 16. Accordingly, these arguments do not appear to be commensurate with the scope of claims and 16, thus, no response can be provided.

Appellant also argues, with respect to claim 16, that with the claimed device the user determines the appropriate format, such as local mode or registered mode, sweepstakes mode or non-sweepstakes mode, where in the prior art of Emmerson, these choices are not possible and in Acres the sweepstake mode is not an option. Nonetheless, claim 16 merely requires the game server to download a plurality of games to the mobile device and provide the user with several options for playing at least some of the games in a

sweepstakes mode. Acres discloses the sweepstakes mode as applicable to a variety of games. Emmerson discloses a number of game menus allowing access to any of the plurality of games on the mobile device, as discussed earlier. Therefore, the combination of Emmerson, as modified, and Acres clearly discloses a mobile device with game menu options, allowing a player to execute one of a plurality of games stored on the mobile device, wherein the at least one game may be a game operable in a sweepstakes mode as taught by Acres.

Claim 15

Appellant, at page 21, argues that “the prior art of Emmerson specializes the game server and uses the communication capability of the phone. This arrangement fails to provide the player development in local mode possible by adapting the game software.” This argument is clearly non-commensurate with the scope of the claim. Claim 15 further devices the personal portable device to be a cell phone used to access and communicate with the game server. Emmerson clearly discloses a mobile phone or cell phone used to access and communicate with a game server (figures 1-2 and paragraph 0005, wherein mobile phones are capable of downloading games from a game server and submitting outcomes to a game server; see also paragraph 0022).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

Art Unit: 3717

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Milap Shah/

Examiner, Art Unit 3717

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/Melba Bumgarner/

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